

Attorney Docket No. WK-0101-US

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 35-57 are presently active in this case, claims 1-34 having been cancelled.

In the outstanding Office Action, claims 1-11, 13 and 17-18 were rejected under 35 U.S.C. §103(a) as unpatentable over and further in view of Shah US 5,028,766, hereinafter the '766 patent, Phillips US 5,839,058, hereinafter the '058 patent, Peters US 5,769,269, hereinafter the '269 patent, and Boyar (Phoenix Arizona Republic Newspaper, Finale Chaser Edition, Weekend Section, 7 August 1992, Page D12), hereinafter the Boyar article. Claims 19-22 and 28-29 were rejected under 35 U.S.C. 103(a) as unpatentable over the '058 patent, the Boyar article and further in view of the '766 patent. Claims 30-32 were rejected under 35 U.S.C. 103(a) as unpatentable over the '269 patent, the '058 patent and further in view of the Boyar article.

Applicants have considered the Examiner's Answer and have amended independent claims 35, 49 and 55 to recite a transaction identifier "electronically notifies the return center that the pre-paid package is being returned when the product is shipped" and "product tracking information."<sup>1</sup> Applicant believes these features are not taught or suggested by the cited references. No new matter has been added by way of the present invention.

With respect to the art cited in the Examiner's Answer, neither of the above limitations are taught. The '269 patent and the '766 patent do not disclose any of the above features. The Boyar article teaches only that it is known in the art to provide a label that has a return address, postage sufficient to mail the product to a return center and the ability to be attached to a second

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<sup>1</sup> See, for example, Claim 35.

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mailer. The Boyar article does not teach or suggest the sending of a shipping notification to the return or providing the return center with tracking data to track the shipment of the package.

The '058 patent teaches, in col. 12, lines 49-52, that "when the user finishes use of the telephone, it is easily returned to the seller ... using the postage pre-paid mailer." Thus '058 patent does not teach that the returning of the product to the seller via mail includes a notification to the seller that the product is being returned. The '058 patent further contains no suggestion of providing tracking data to the seller for tracking the shipment of the product.


Consequently, in view of the present amendments, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 35-57 is earnestly solicited.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Timothy J. Maier, Reg. No. 51,986, at the number listed below.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact the undersigned representative at the below listed telephone number.

Respectfully submitted,

KEADY OLDS & MAIER PLLC



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